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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,866	08/09/2004	Lynette I. Hotchkiss	800760	4865
23372	7590	10/31/2006	EXAMINER	
TAYLOR RUSSELL & RUSSELL, P.C. 4807 SPICEWOOD SPRINGS ROAD BUILDING TWO SUITE 250 AUSTIN, TX 78759			LY, CHEYNE D	
			ART UNIT	PAPER NUMBER
			2168	

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/710,866	HOTCHKISS, LYNETTE I.	
	Examiner	Art Unit	
	Cheyne D. Ly	2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>Nov. 22, 2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-38 are examined on the merits.
2. In view of the papers filed March 11, 2005, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding inventors: Timothy T. Green and Angela Cheek.
3. The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

CLAIM INTERPRETATIONS

4. Claim 1, line 11, recites the limitation of “preparing a rule documentation report if a change is required...” wherein said limitation supports that the “preparing a rule documentation report” is required when the conditional limitation is met. Otherwise, no report is prepared (alternatively, second embodiment) when the conditional limitation is not met. Additionally, the steps following lines 11-16 are only performed when the report is prepared, which further supports that the steps following the conditional statement are optional. Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed. (see MPEP 2111.04 [R-3]).

OBJECTIONS

5. The abstract of the disclosure is objected to because said abstract is greater 150 words.

Applicant is required to file a new abstract on a separate sheet of paper. See MPEP § 608.01(b).

CLAIM REJECTIONS - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
8. Claims 1-38 are rejected because said claims are directed to a method and system which do not produce any concrete and tangible results. Claim 1, line 11, recites “a rule documentation report” is only prepared when a change is required. A reasonable interpretation is that “a rule documentation report” is not produced with a change is not required. As evidenced by claim 1, the claimed invention does not produce a tangible and concrete result when “a rule documentation report” is not prepared. Further, claims 5 and 6 recite “The method of claim 1, further...” which has been interpreted to occur after the conditional limitation of “if a change is required.” Therefore, a reasonably interpretation is that the limitation of claims 5 and 6 are not performed with a change is not required. Therefore, said claimed invention is nonstatutory.
9. Specific to claims 24-30, the claims are directed to nonstatutory subject matter because said claims are directed to descriptive material. Specific to the limitation of “system...”, said claims do not recite any structural limitations that would support said system is not

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merely software code, descriptive material. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. However, that is not the case for the claimed invention because claims 24-30 do not recite any limitations that the descriptive material is recorded on some computer-readable medium. Further, the claims recite such limitations as “a law...”, “checklist...”, documentation report...”, etc. wherein said limitations have been interpreted as mere nonfunctional descriptive material. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759.

CLAIM REJECTIONS - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-6 and 8-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Sziklai et al. (US 6,341,287 A1) (Sziklai hereafter).

12. For the instant prior art rejection, the prior art is directed to the alternative embodiment wherein a change is not required; therefore, a rule documentation is not prepared.

Therefore, limitations that are optional are not mapped to the prior art because they are not required.

13. In regard to claim 1, Sziklai discloses a method for generation and maintenance of a regulatory compliance rules repository for regulatory compliance assessment (Abstract etc., and column 9, lines 4-13), comprising the steps of:
- Comparing a law imposing requirements for a regulated transaction with a compliance subject checklist for determining whether a change is required in the regulatory compliance rules repository of a regulatory compliance assessment system (column 9, lines 26-32, especially, “monitors, responds to, and incorporates changes in, federal, state, and local laws, statutes, ordinances and regulations”), the compliance subjects checklist listing subjects addressed by the regulatory compliance assessment system (column 9, lines 26-42, especially, “worklists”). The limitations following line 16 have been reasonably interpreted as optional; therefore, are not mapped to the prior art because they are not required.
14. In regard to claims 2-4, Sziklai discloses the claimed invention as cited above. Further, claims 5-14 are dependent on the optional limitation of “preparing a rule documentation report if a change is required...” wherein said claims have been interpreted as not being required when the “a change is not require.” Further, claims 5 and 6 recite “The method of claim 1, further...” which has been interpreted to occur after the conditional limitation of “if a change is required.” Therefore, a reasonable interpretation is that the limitation of claims 5 and 6 are not performed with a change is not required.
15. Sziklai describes claims 15-38 as cited and discussed above.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sziklai et al. (US 6,341,287 A1) (Sziklai hereafter) as applied to claims 1-6 and 8-38 above, and further in view of Lawrence (US 2002/0143562 A1).

19. Lawrence describes a method to address the need for a method and system to draw upon information gathered globally (page 1, [0009]). While, Sziklai describes an improvement for integrating information from a plurality of databases without requiring the (re)programming the underlying software (column 8, lines 4-21). Therefore, one of

ordinary skill in the art at the time of the invention would have been motivated by Sziklai to improve the method and system described by Lawrence.

20. In regard to claim 7, Sziklai describes all the required limitations of said claims except for the limitation of comparing by an in-house legal team. Lawrence describes the limitation of comparing by an in-house legal team (page 2, [0025]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to make and used the method described by Lawrence and Sziklai for integrating information from a plurality of databases without requiring the (re)programming the underlying software.

CONCLUSION

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Megley (US 2005/0066021 A1) and Kennedy (US 2002/0178039 A1).
22. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides

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Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

23. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is 571-272-8300.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716.

The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo, can be reached on (571)272-3642.

C. Dune Ly *CDL*
Patent Examiner
10/28/06



TIM VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100